

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2223632 IN THE NAME OF
BAISEMARK LIMITED TRADING AS NORTHERN SUEDE AND LEATHER
TO REGISTER THE TRADE MARK BARNEYS IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER No 80556
BY BARNEY'S INC

DECISION

Introduction

1. On 26 February 2000, Baisemark Limited trading as Northern Suede & Leather, applied to register BARNEYS as a trade mark in Class 25 in respect of "outer clothing of leather".
2. On 17 January 2002 Barney's Inc filed a notice of opposition to the application on grounds raised under section 5(4)(a) and section 32(2)(b) of the Trade Mark Acts 1994.
3. The ground of objection under section 5(4)(a) was based upon the use by the opponent of the mark BARNEY'S for many years as the name of its store in New York through which it has sold high quality clothes, accessories and other personal items.

4. The ground of objection under section 32(2)(b) was based upon the contention that the application was originally filed in the name of Northern Suede & Leather Limited, a business or entity which did not exist.
5. By a written decision dated 23 February 2004 Mr Foley, the Hearing Officer acting for the Registrar, dismissed both grounds of opposition.

The application

6. The history of the application was set out in a short witness statement of a Mr Gee, a solicitor employed by the firm of Wacks Caller, dated 23 August 2001. He explained that his firm was instructed by the applicant and in turn provided instructions to the trade mark attorneys, Wilson Gunn M'Caw. Mr Gee assumed responsibility for the application when his colleague, Mr Shipley, left the firm.
7. Mr Gee explained that initial instructions were given to Wilson Gunn M'Caw to file the application in the name of Northern Suede & Leather Limited by Mr Shipley. This was an error since the correct name of the applicant was Baisemark Limited trading as Northern Suede & Leather. As soon as the error in the name of the applicant was spotted, instructions to make a correction were sent by Mr Shipley to Wilson Gunn M'Caw. On 9 January 2001 an application was duly made to have the name of the applicant corrected. That correction was allowed by the Registrar under section 39 of the Act.

The Decision of the Hearing Officer

8. The Hearing Officer first addressed the objection under section 32. He considered that the correction was properly made under section 39 but that the original application failed to satisfy the requirements of section 32(2). Accordingly he directed that, pursuant to section 33(1), the filing date of the application must be amended to 9 January 2001, the date that the correct name was furnished to the Registrar.

9. The Hearing Officer then turned to consider the objection under section 5(4)(a). He noted that the evidence filed by the opponent covered a period both before and after the amended filing date. Accordingly, and, as he put it, in the interest of fairness, he allowed the opponent a further period of two months from the date of the hearing in which to file additional evidence, but on the basis that if the evidence was available at the time of filing of the original evidence then it had to be accompanied by an explanation as to why it had not been filed earlier, and that failure to provide an explanation would result in the evidence not being accepted. In the event, the Hearing Officer arrived at his decision under section 5(4) having considered the evidence contained in two witness statements of a Mr Marc Perlowitz, the Executive Vice President and General Counsel of the opponent. The first was dated 22 August 2002 and the second was dated 8 January 2004, that is to say within the additional two month period allowed by the Hearing Officer.
10. The Hearing Officer addressed the substantive objection under section 5(4)(a) by first setting out the relevant legal principles. In particular he referred to the summary of the legal requirements of the cause of action set out in Halsbury's Laws of England, 4th Edition, Volume 48, at paragraphs 165 and 184 to 188. Insofar as relevant to this appeal, I need only cite the following passage from paragraph 165:

“The necessary elements of the action for passing off have been re-stated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The re-statement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

11. The Hearing Officer also referred to the following observations of Pumfrey J. in *REEF Trade Mark* [2002] RPC 19 at [27] and [28]:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application OVAX* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and public, and will be supported by evidence of the extent of use. To be useful the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

In *REEF* the judge concluded that the Hearing Officer was right to decide that the opponent had not proved its case and, on further appeal, the Court of Appeal decided that the judge was right not to disturb the Hearing Officer's decision: [2002] EWCA Civ 763; [2003] RPC 5 at [47].

12. The Hearing Officer then proceeded to consider the evidence filed on behalf of the opponent and contained in the two witness statements of Mr Perlowitz. The Hearing Officer had no doubt that the opponent had a strong reputation and goodwill in the United States under the name BARNEY'S. However, he reached the conclusion that the opponent had failed to establish that, as of 9 January 2001, it had a reputation and goodwill under that mark in the United Kingdom. He therefore dismissed the ground of opposition founded on section 5(4)(a).

The issues on the appeal

13. The opponent contended that the Hearing Officer fell into error in three main respects. First, he ought to have refused the application on the basis that it was made in the name of a business or entity which did not exist. Secondly, the opponent was given no proper opportunity to address the consequences of according to the application a new filing date. Thirdly, the Hearing Officer erred as a matter of law in placing upon the opponent too high a burden of proof under section 5(4).

Section 32

14. The relevant sections of the Act are:

Application for registration

32. - (1) An application for registration of a trade mark shall be made to the registrar.
- (2) The application shall contain
 - (a) a request for registration of a trade mark,
 - (b) the name and address of the applicant,

- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
 - (d) a representation of the trade mark.
- (3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.
- (4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

Date of filing

33. (1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

If the documents are furnished on different days, the date of filing is the last of those days.

- (2) References in this Act to the date of application for registration are to the date of filing of the application.

Withdrawal, restriction or amendment of application

39. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

- (2) In other respects, an application may be amended, at the request of the applicant, only by correcting
- (a) the name or address of the applicant,
 - (b) errors of wording or of copying, or
 - (c) obvious mistakes,
- and then only where the correction does not substantially affect the identity of the trade

mark or extend the goods or services covered by the application.

- (3) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it”.

15. In addition I must refer to the relevant rule which reads:

Deficiencies in application; s.32

11. Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1) or 8(2), the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of section 32(4), the default of payment and if within two months of the date of the notice the applicant
 - (a) fails to remedy any deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made; or
 - (b) fails to remedy any deficiency notified to him in respect of section 32(3) or rule 5(1) or 8(2) or fails to make payment as required by section 32(4) the application shall be treated as abandoned.
16. The primary contention advanced on behalf of the opponent was that the original application was deficient and contrary to section 32 and not susceptible to correction under section 39. The submission was developed as follows. First, no applicant was identified because the name given was not the name of any existing entity. Further, even if an entity which did not exist could be treated as an applicant, it could have no address, could not have made any use of the mark applied for and could have had no intention to use the mark in the future. Accordingly the application should have been refused for failure to comply with section 32(2) and (3). Further, it was contended, although section 39 permits the making of an application to amend by

correcting the name or address of the applicant, such an application must be made “*at the request of the applicant*”. In this case there was no existing entity to make such a request and, in any event, the consequence of doing so would not have been to “*correct*” the name of the applicant, but to “*insert*” the name of an applicant where no such entity had previously been identified at all.

17. I am unable to accept these submissions. A name is a word or set of words by which someone is known. Further, the purpose of section 32(2)(b) is to provide sufficient information to identify the applicant and its address. Article 26 of the Community Trade Mark Regulations contains a similar provision requiring an application for a Community Trade Mark to contain “*information identifying the applicant*”.
18. Section 39(2)(a) permits the amendment of an application, at the request of the applicant, by correcting the name or address of the applicant. This provision contemplates that some error may be made in the supply of the information required by section 32(2)(b). It also contemplates that such an error may be corrected. It contains two requirements. First, the application must be at the request of the applicant. This, to my mind, means that the original application must have been made by or on behalf of the particular entity which seeks the correction. Secondly, the amendment must be one which can fairly be described as a correction. I do not believe it would cover, for example, a situation where the name or address had been left out of the original application altogether.
19. In this case the original application identified an entity called Northern Suede & Leather Limited carrying on business from 12 Stocks Street, Manchester M8 8QG. The application claimed the applicant was using or intended to use the mark BARNEYS as a trade mark in relation to articles of clothing. At the date of the application there was indeed an entity carrying on business from 12 Stocks Street under the trade name Northern Suede & Leather and it was

selling leather garments under the trade mark BARNEYS. It had been trading in this way for a number of years. Accordingly, it is to my mind quite unreal to suggest that at the date of the application the applicant did not exist as an entity. Moreover, I believe the application did refer to and identify that entity and that entity alone, albeit not by its correct corporate name Baisemark Limited.

20. I have also carefully considered the evidence of Mr Gee and I am quite satisfied that a genuine error was made when the original application was filed in the name of Northern Suede and Leather Limited rather than in the name of Baisemark Limited, trading as Northern Suede and Leather.
21. In these circumstances I have reached the clear conclusion that both of the requirements of section 39(2)(a) were satisfied in the present case. The evidence establishes that it was Baisemark Limited which gave instructions for the original application to be filed and that the application to amend was made by that entity. Further, I think it is fair to describe the change from the applicant's trading name to its corporate name as one of correction. In my judgment the Hearing Officer was right to conclude that the amendment of the name of the applicant was a permissible correction under section 39 of the Act.
22. The Hearing Officer then turned to consider the application of section 33 of the Act. He took the view that the name of the applicant was not furnished to the Registrar until the date of the application to amend, that is to say 9 January 2001. Accordingly he directed that the filing date be amended to that date.
23. This approach was also criticised by the opponent. It contended that the application to amend the name of the applicant fell outside the scope of anything contemplated by section 32 and section 33 and, moreover, the application to amend was made outside any period contemplated by rule 11.

24. In my judgment the approach adopted by the Hearing Officer was, if anything, unduly favourable to the opponent. Section 33 deals with the case where the original application fails to contain everything required by section 32(2). In such circumstances the date of filing is the date upon which documents containing everything required by section 32(2) are furnished to the Registrar. But that is not this case. Here the original application did contain everything required by section 32(2), albeit that it required correction. No amendment to the date of filing was therefore required. Nevertheless no appeal was filed against this aspect of the decision by the applicant, nor was any request made at the hearing before me to vary it. Accordingly I will make no order in relation to it.
25. Further, I reject the submission made as to the proper interpretation of rule 11. That provides that the Registrar must give notice to the applicant of any failure to satisfy the requirements of section 32(2), (3) or (4), and that the deficiency must be remedied within two months of the date of such notice. If it is not then the application is deemed never to have been made. It means that the applicant must respond to the notice within a reasonable period of time. But there may be rare cases where the deficiency is not apparent on the face of the application or where it escapes the attention of the Registrar. In such cases no notice will be sent and the two month period cannot begin to run. But in such cases the deficiency in the application will, of course, remain and, pursuant to section 33, the application will not be afforded an application date until it is remedied.

The new filing date

26. The opponent contended that it was not given a proper opportunity to address the matters arising in consequence of the amended application date and that this constituted a serious procedural error. It sought remission of the matter for re-hearing together with permission to supplement its evidence in relation to the extended time period and without the restriction imposed by the Hearing Officer and which I have referred to in paragraph 8 above.

27. It follows from the conclusions I have expressed in the preceding section of this decision that there was no need to afford to the opponent an opportunity of filing further evidence. Nevertheless, I am, in any event, quite satisfied that the approach the Hearing Officer took was entirely reasonable. The first statement of Mr Perlowitz was dated 22 August 2002. In that statement he sought to address the reputation and goodwill attaching to the opponent from the commencement of its business in 1923 until the date of the statement itself. It covered the period including the original application date of 26 February 2000 and the revised application date of 9 January 2001. The oral hearing took place before the Hearing Officer on 11 November 2003. It was at that hearing that the Hearing Officer gave the direction that the opponent had a further two months in which to file additional evidence, but subject to the restriction I have identified. The second statement of Mr Perlowitz was dated 8 January 2004 and once again contained evidence directed to establishing the reputation of the opponent from 2000 through to December 2003. No objection was taken to the aspects of the evidence available before 22 August 2002. Nor was it suggested that the opponent felt constrained by the Hearing Officer's order to omit evidence from the second statement which it would otherwise have sought to advance.

Section 5(4)

28. The third ground relied upon by the opponent related to the manner in which the Hearing Officer approached the issue of passing off. In assessing these submissions I must have in mind the correct approach to cases such as this as explained by the Court of Appeal in *REEF* at [28]:

“In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

29. The opponent submitted that the Hearing Officer fell into error in failing to accept the unchallenged evidence that, by 9 January 2001, the opponent had

customers in the United Kingdom and had advertised extensively in the New York Times publication which is readily available here. It was said that, in adopting the approach which he did, the Hearing Officer erred as a matter of law in placing upon the opponent too high a burden of proof.

30. I have carefully considered the two statements that were submitted on behalf of the opponent. Those statements do establish that at all material times the opponent had a significant reputation in the United States. BARNEY'S evidently is and was a well-known store in New York. The opponent also had BARNEY'S stores in Beverley Hills, Boston, Chicago, Manhattan and Seattle. Not surprisingly, it advertises in United States publications, some of which circulate into the United Kingdom, and it has a website through which garments and other goods may be bought.
31. Nevertheless I believe that the evidence of the opponent fails to establish that, by 9 January 2001, the reputation and goodwill of the opponent extended to the United Kingdom such that the sale by the applicant of leather outer garments in the United Kingdom would be likely to lead to the belief that such goods were the goods of or connected with the opponent.
32. The evidence filed by the opponent gave no details of any sales of goods into the United Kingdom under the name BARNEY'S either directly or from the website and no details of any advertising or promotion directed to United Kingdom or other overseas customers. Further, no details were provided of the extent to which United States publications containing advertisements for the opponent's stores circulated in the United Kingdom. In my judgment it is not good enough for an opponent simply to assert that it has, at the relevant date, acquired a reputation and goodwill as a result of sales made under a particular mark without providing any details of such sales or supporting promotional material which would allow that claim to be assessed.

33. I accept that it is inevitable that some United Kingdom consumers visiting the United States must have visited the opponent's BARNEY'S stores and bought goods there but the evidence provides no details of the likely numbers of such visitors or the extent to which the opponent's stores had, as a result, acquired a reputation in the United Kingdom. Nor does the evidence provide any basis upon which to assess a claim that the reputation of the opponent was such that the use of the trade mark BARNEYS in relation to leather garments would or might lead to deception.
34. In summary, the evidence filed on behalf of the opponent did not, in my view, raise a prima facie case that the use of the trade mark BARNEYS in relation to outer clothing of leather would be likely to lead to passing off. The Hearing Officer did not err in a matter of law in placing upon the opponent too high a burden of proof. On the contrary, he simply analysed the evidence carefully and reached the conclusion, rightly in my view, that it failed to establish that, at the relevant date, the opponent had acquired in the United Kingdom a relevant reputation and goodwill.

Conclusion

35. In all the circumstances the appeal must be dismissed.
36. The Hearing Officer considered that the opposition had been successful, albeit only insofar as it led to an amendment of the filing date. In the circumstances he ordered the applicant to pay to the opponent the sum of £1,000. On the appeal the opponent has been wholly unsuccessful. The applicant is entitled to an award of costs in the same sum. Accordingly I direct that the costs order of the Hearing Officer be set aside and that there be no order as to costs either before me or before the Hearing Officer.

David Kitchin QC

10 July 2005

Miss Fiona Clark instructed by McGuire Boss appeared on behalf of the opponent

Mr Hill of Wilson Gunn M'Caw appeared on behalf of the applicant